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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,210	07/28/2003	Daniel G. Brady	27556	5311

7590

12/14/2005

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No.	Applicant(s)	
	10/629,210	BRADY ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-14 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-14 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/22/05</u> | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 22, 2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 7, 8, 13, 14, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al (WO 03/000154). Miller anticipates the claim language where refractive lenses of negative or positive powers can be substituted with lenses that are diffractive; see Figures 1 and 1A as well as page 6, line 21 to page 7, line 6. The supplemental lens as claimed is any of the lenses of Miller.

Claims 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (US 5,117,306). Cohen anticipates the claim language where the primary and

Art Unit: 3738

supplemental lenses as claimed are met by the multiple lens structures thereof; see the Figures. Cohen teaches that the lenses can be both positively and negatively powered to correct for chromatic aberration; see claim 19 and 22 thereof.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 8, and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman et al (US 6,197,057) in view of Cohen (US 5,117,306). Peyman meets the claim language where the primary lens as claimed is met by the intraocular lens already implanted, and the supplemental lens as claimed is the supplemental lens of Peyman et al; see the abstract, column 9, lines 7-42, and column 5, line 64 to column 6, line 4. But Peyman fails to describe the details of the diffractive lens embodiment, and thus, fails to disclose the use of positively or negatively powered lenses, echelettes, and the diffraction profile. However, Cohen teaches that it was known to make diffractive intraocular lenses that are positively or negatively powered, that include echelettes, and that have first or multi-ordered profiles as claimed; see the previously cited portions thereof. Therefore, it is the Examiner's position that it would have been obvious to provide a diffractive supplemental lens having the characteristics

disclosed by Cohen for the same reasons Cohen uses the same and in order to make a wide variety of lenses suitable for many different patients.

Regarding claim 35, the echelettes of the formula of column 1, line 35 are on the order of a wavelength of light in size. For this reason, they would not be visible to the naked eye since they are so small.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) and Cohen (US 5,117,306) as applied to claims 1-3,7, 8, and 31-39 above, in further view of Patel (US 5,366,502). Peyman meets the claim language as explained *supra* but fails to use of a multifocal or toric diffractive lens as claimed. However, Patel teaches that such lenses were known; see column 8, lines 1-10. Therefore, it is the Examiner's position that it would have been obvious to use an multifocal or toric lens in the Peyman invention for the same reasons that Patel uses the same and in order to enable near and far vision (via a multifocal lens) and to aid a patient with an astigmatism (via a toric lens).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) and Cohen (US 5,117,306) as applied to claims 1-3,7, 8, and 31-39 above, in further view of Portney (US 6,197,058) or Nordan et al (US 2003/0097176). Peyman fails to teach the thickness of the diffractive supplemental lens as claimed. However, Portney (see column 7, lines 59-62) and Nordan (see abstract) both teach that lens thicknesses of less than 250 microns were known. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to make the

Art Unit: 3738

Peyman supplemental lens less than 250 microns thick for the same reasons as the secondary references, and in order to make the lens insertable through a small incision.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyman (US 6,197,057) and Cohen (US 5,117,306) as applied to claims 1-3, 7, 8, and 31-39 above, in further view of Copeland et al (US 2002/0042653). Peyman fails to teach a blue blocker or tint feature as claimed. However, Copeland teaches that it was known to incorporate blue blocking or tint into intraocular lenses prior to the invention of the Applicants' invention; see the abstract. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to incorporate blue blocker or tint into the lens of Peyman for the same reasons that Copeland does the same, that is, to achieve maximum visual acuity.

Response to Arguments

Applicant's arguments filed September 22, 2005 have been fully considered but they are not persuasive.

In response to Applicants' argument that Peyman does not teach a diffractive lens to modify vision correction, the Examiner disagrees and asserts that the intent of Peyman is clearly to correct vision. In one embodiment, Peyman discloses using a diffractive lens to accomplish this. The argument that the lenses of Peyman are not enabling for diffractive lenses constitutes a mere allegation since there is no proof thereof. Since the ability to make diffractive intraocular lenses is notoriously old to the art, it is the Examiner's position that one skilled in the art would be able to make the lenses suggested by Peyman without undue experimentation.

In response to the traversal that Peyman is not combinable with Cohen because it is not for Peyman does not disclose a lens that is positively or negatively powered, and thus, would not desire a Cohen lens. Although Peyman prefers a lens with no power in one embodiment, he certainly does not teach against using a lens with a power because in the first embodiment his discloses using a lens with a negative power. For this reason, it is clear that Peyman prefers a diffractive lens that has no refractive power.

Conclusion


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebille whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul B. Prebille
Primary Examiner